



Attorney's Docket No. S&P.33944

1623

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the HIROFUMI YURA ET AL.
Application of:
Application No.: 09/937,991
Filing Date: 01/23/2002
Title: FUNCTIONALIZED
 GLYCOSAMINOGLYCAN
 POLYMER AND MEDICAL
 INSTRUMENTS AND DRUGS BY
 USING THE SAME

Examiner: KRISHNAN,
 GANAPATHY
Art Unit: 1623

RECEIVED
AUG 20 2003
TECH CENTER 1600/2900

AMENDMENT TRANSMITTAL

The Assistant Commissioner for Patents
BOX FEE AMENDMENT
P.O. Box 1450
Alexandria, VA 22313-1450

Transmitted herewith is an amendment for this application.

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as 1st Class Mail addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 08/14/03.

By: Hollen M. Gyzelski

The fee for claims has been calculated as shown below:

| CLAIMS | FOR | CLAIMS REMAINING AFTER AMENDMENT | HIGHEST NUMBER PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE | CALCULATIONS |
|--------|--|---|---|------------------|-------------------------------|--------------|
| | TOTAL CLAIMS (37 C.F.R. § 1.16(e)) | | - 20 | = 0 | x \$18.00 = | \$ |
| | INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b)) | | - 3 | = | x \$84.00 = | \$ |
| | MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d)) | | | | + \$280.00 | \$ |
| | | | | | Total of Above Calculations = | \$ |
| | Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27, 1.28). | | | | | |
| | TOTAL = | | | | | \$ |

_____ Applicant hereby claims small entity status under 37 C.F.R. § 1.27.

_____ A check is enclosed to cover the \$ fee for the presentation of additional claims.

XX_____ Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition for an extension of time.

_____ Applicant hereby petitions for a:

_____ one month (37 C.F.R. § 1.17(a): \$110.00/\$55.00)
 _____ two month (37 C.F.R. § 1.17(b): \$410.00/\$205.00)
 _____ three month (37 C.F.R. § 1.17(c): \$930.00/\$465.00)
 _____ four month (37 C.F.R. § 1.17(d): \$1,450.00/\$725.00)
 _____ five month (37 C.F.R. § 1.17(d): \$1,967.00/\$9850.00)

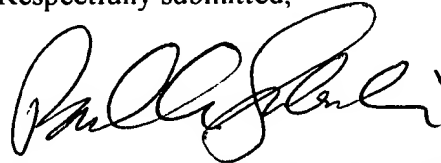
extension of time pursuant to 37 C.F.R. § 1.136(a). If an additional extension of time is required, please consider this a petition therefor.

_____ A check is enclosed to cover the \$ extension of time fee under 37 C.F.R. § 1.17.

_____ Charge Deposit Account No. 16-0820 (our Order No. S&P.33944) in the amount of \$_____.

X The Commissioner is hereby authorized to credit any overpayment or to charge any fees under 37 C.F.R. §§ 1.16, 1.17 in connection with this communication to our Deposit Account No. 16-0820 (our Order No.S&P.33944).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul A. Serbinowski".

Paul A. Serbinowski, Reg. No. 34429

Date: August 14, 2003

PEARNE & GORDON LLP
Ohio Savings Building
526 Superior Avenue East
Suite 1200
Cleveland, OH 44114
Phone: (216) 579-1700
Facsimile: (216) 579-6073



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#11
8-20-03
PATENT
RECEIVED

AUG 20 2003

TECH CENTER 1600/2900

In re application of: Hirofumi Yura et al.

Serial No.: 09/937,991

Group Art Unit: 1623

Filed: 01/23/2002

Examiner: Krishnan, Ganapathy

Title: FUNCTIONALIZED GLYCOSAMINOGLYCAN POLYMER AND MEDICAL INSTRUMENTS AND DRUGS BY USING THE SAME

Docket: 33944

Pearne & Gordon LLP
526 Superior Avenue East
Suite 1200
Cleveland, OH 44114-1484
Telephone: (216) 579-1700
Facsimile: (216) 579-6073
Email: ip@pearnegordon.com

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION AND
ELECTION OF SPECIES REQUIREMENT**

Dear Sir:

This is in response to the Office Action mailed July 15, 2003. Applicants hereby provisionally elect, with traverse, to prosecute the following:

a) The invention of Group I, drawn to a functionalized polymer having the structure:

-(CWX-CYZ)_n- (claims 1-3 and 6-10 falling into elected Group I); and

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as first class mail addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date: 08/14/03

By: Jellon M. Szeglah

b) The species for W in formula I: heparin/heparan sulfate or a partially desulfated modification thereof as listed in claim 3 (claims 3, 9 and 10 being readable on the elected species).

Currently, independent claims 1 and 7 are generic to all species. Claims 3, 5, 9 and 10 depend from claims 1 or 7. It is noted that when claims to nonelected species are fully embraced by allowable generic claims, the claims shall no longer be withdrawn. MPEP 809.02. Upon the allowance of claims 1 and 7 all claims which depend therefrom should be in condition for allowance including claims 3, 9 and 10 which feature the non-elected species and claim 5 which features the nonelected invention of Group II.

The Office Action asserts that the inventions of the two groups do not relate to the same inventive concept because they lack the same technical features under PCT rules. Applicants' undersigned representative respectfully notes that U.S. law and regulations control in this U.S. national patent application. Upon the allowance of claim 1, Applicants reserve the right to reintroduce the nonelected invention of claim 5. Also, upon the allowance of generic claims 1 or 7 Applicants also reserve the right to reintroduce the nonelected species featured in claims 3, 9 or 10.

The avowed purpose of the Patent and Trademark Office in requiring restriction, is the avoidance of a burdensome examination and multiple surfaces. However, MPEP §803 provides that if the search and examination of an entire application can be made without serious burden the Examiner must do so even if it is considered to include claims to two different or independent inventions.

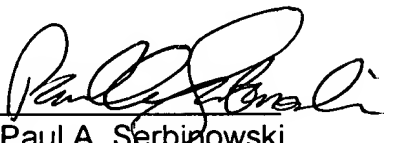
It is respectfully submitted that the examination of all of the claims of this application will not place an undue burden on the PTO. Accordingly, Applicants

respectfully request that the Examiner withdraw the restriction and species requirements and that he concurrently examine the claims of Groups I and II and all species in this application.

Respectfully submitted,

Pearne & Gordon LLP

Dated: August 14, 2003

By: 
Paul A. Serbinowski
Reg. No. 34,429